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AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/058,810 04/13/98 NEGELE

U 225/44173

EXAMINER

IM52/0522

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1200 G STREET NW
SUITE 700
WASHINGTON DC 20005

CHEN, V

ART UNIT

PAPER NUMBER

1773

DATE MAILED:

05/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/058,810

Applicant(s)
NEGELE et al

Examiner
Vivian Chen

Art Unit
1773



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2-28-01
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-50 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

1. Claims 1-27 have been cancelled.

Specification

2. The amendment filed 6/8/2000 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the newly added limitation precluding conjugated double bonds. Negative limitations to amend claims around the prior art constitute new matter if not supported by the specification. *Ex Parte Grasselli*, 231 USPQ 393.

Applicant is required to cancel the new matter in the reply to this Office action.

Claim Rejections - 35 USC § 112

3. Claims 28-50 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons stated above in the objection under 35 U.S.C. 132 of the amendment filed 6/8/2000. Applicant should point out with specificity any alleged support for the amended claim language.

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4. The rejections of claim 44 under 35 USC 112, first paragraph, in paragraph 2 of the previous Office Action have been withdrawn in view of Applicant's arguments regarding a typographical error during the translation of the priority document.

Response to Arguments

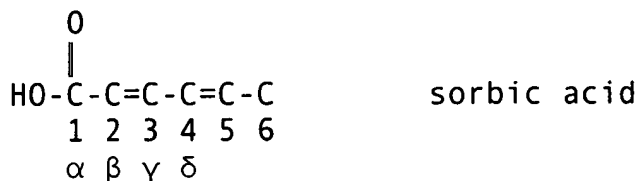
5. Applicant's arguments filed 2/28/2001 have been fully considered but they are not persuasive.

(A) Applicant argues that the disclosure as originally filed provides implicit support for the negative limitation "with exception of conjugated double bonds", relying upon the Negele declaration. However, while the declaration and Applicant contends that one of ordinary skill in the art would clearly recognize from the specification and the list of preferred compounds with conjugated double bonds are undesirable and to be excluded, the Examiner is not persuaded. As admitted by the Negele declaration, one of the compounds explicitly disclosed in the specification as a preferred material is sorbic acid, which contains double bonds which alternate with single bonds -- this meets the commonly recognized definition of "conjugated double bonds". Although sorbic acid may not be as prone to undergoing a Diels-Alder reaction as other compounds containing conjugated double bonds, it must be noted that the claims do not specify the exclusion of compounds capable of undergoing a Diels-Alder reaction, but rather the present claims require the flat exclusion of compounds containing conjugated double bonds in any form. It is the

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Examiner's position that the specification does not clearly provide, either explicitly or implicitly, adequate support for the exclusion of compounds with conjugated double bonds, and that one of ordinary skill in the art would *not* reasonably infer from the disclosure (as originally filed) that compounds with conjugated double bonds must be avoided, particularly since the specification explicitly discloses a preferred material which in fact contains conjugated double bonds, as commonly recognized by those of ordinary skill in the art. The fact that the other functional groups in sorbic acid might materially affect its reactivity in regards to a Diels-Alder reaction (e.g., sorbic acid does not undergo a Diels-Alder reaction) is irrelevant.

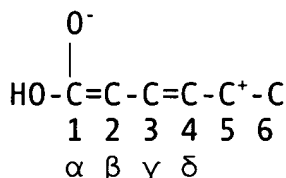
Additionally, it is also unclear to the Examiner how the declared conjugation of the α,β -double bond with the carboxylate group in sorbic acid would result in the γ,δ -double bond acting as an isolated double bond. It would appear that sorbic acid (2,4-hexadienoic acid) should have 2,4-double bonds (double bonds between the 2nd and 3rd carbons, and between the 4th and 5th carbons), not 1,3-double bonds as stated by the Negele Declaration (paragraph 5) or a α,β -double bond in combination with a γ,δ -double bond.



However, if the Negele declaration is referring to a resonance structure in which contains an α,β -double bond and a γ,δ -double bond, the Examiner notes that the α,β -double bond and the

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γ,δ -double bond are *still* conjugated and that the γ,δ -double bond does not appear to be isolated as the Negele declaration indicates (see figure below).



Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday-Thursday from 8:30 AM to 6:00 PM and on alternate Fridays from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Paul Thibodeau, can be reached on (703) 308-2367.

For Art Unit 1773, the fax phone numbers are as follows:

official faxes:

(703) 305-3601

(703) 305-7718

unofficial faxes:

(703) 305-5436

(703) 305-3602

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is (703) 308-0661.

VC

May 18, 2001



Vivian Chen
Primary Examiner
Group 1700